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| 09/801,725 | 03/09/2001 | Tim King | 1591.0050001/RES/RDL | 5084 |
| 26111 | 7590 | 03/25/2004 | EXAMINER | |
| STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 | | | DANG, KHANH NMN | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2111 | |

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/801,725

Applicant(s)

KING ET AL.

Examiner

Khanh Dang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Objections

Claim 7 is objected to because of the following informalities: inline 2, after "plurality of", the word – classes—should be inserted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1-4, 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 4, and 11 are directed to an apparatus claim. However, the essential structural cooperative relationship between the so-called "means for mapping" and other recited elements in the claims have been omitted, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

In claim 8, line 4, the phrase, "sending an email using physical address of a recipient" is unclear. As disclosed, an email is sent to a recipient using e-mail address after matching the recipient's physical address with the recipient's e-mail address.

In claim 10, lines 12-13, the phrase, "the physical address of said buyer is used to send said email" is unclear. As disclosed, an email is sent to a recipient using e-mail address after matching the recipient's physical address with the recipient's e-mail address.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 11, 13, 14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan.

With regard to claims 1, 5, and 14, Hogan discloses a system for routing e-mails, comprising: a server (160, for example) that includes a database, the database including a mapping from a physical address to an e-mail address (in Hogan, each regular mail has a corresponding email address), wherein the server (160) is connected to a network (110, for example), the server (160) further including an electronic mailbox (email box) for each physical address (regular mail), wherein the electronic mailbox is associated with an account number and password (see at least Fig. 2a and description thereof); and a recipient host (100, for example) that includes a web browser, the recipient host connected to the network (110), wherein the host can access e-mails on the server (160) using the account number and the password. With regard to claims 2 and 4, it is clear that in Hogan, the recipient can print the email from the server (160)

and send using regular mail. The recipient can also choose not to open the email, and as a result, the e-mail be printed and forwarded via regular mail. With regard to claim 3, it is clear that the server (160) provides a graphical user interface (Figs. 3 and 4, for example) that allows a recipient to select whether electronic mail is delivered to the electronic mailbox or is delivered via traditional mail. With regard to claim 11, it is clear that the address of a user stored in a database can always be edited. With regard to claim 13, it is clear that each recipient is assigned with an email box. With regard to claim 16, it is clear that emails can be printed and mailed via traditional mail. Furthermore, Hogan discloses that physical address and email address of a recipient are stored in a database.

However, Hogan does not disclose a means for mapping a physical address of a recipient to an email address of the recipient.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of searching a recipient's email address using a recipient's physical address, since the Examiner takes Official Notice that searching for a particular predetermined information using a key word or phrase in a data base is old and well-known; and providing Hogan with such a search capability only involves ordinary skill in the art.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan as applied to claim 5 above, and further in view of Daniels, Jr. et al.

The further difference between Hogan and the claimed subject matter is the method of selectively tagging or identifying a particular class of emails for delivering either electronically or via traditional mail. Daniel, Jr. et al. discloses a method of sorting emails based on method of delivery and delivery designated emails via either postal mail or email (see at least Figs. 1 and 2, and description thereof). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of sorting mails and delivering mails based on a recipient's choice via either email or traditional mail, as taught by Daniels, Jr. et al., for the purpose of upgrading the mail system of Hogan.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Daniel Jr. et al.

Hogan discloses a system for routing e-mails, comprising: a server (160, for example) that includes a database, the database including a mapping from a physical address to an e-mail address (in Hogan, each regular mail has a corresponding email address), wherein the server (160) is connected to a network (110, for example), the server (160) further including an electronic mailbox (email box) for each physical address (regular mail), wherein the electronic mailbox is associated with an account number and password (see at least Fig. 2a and description thereof); and a recipient host (100, for example) that includes a web browser, the recipient host connected to the network (110), wherein the host can access e-mails on the server (160) using the account number and the password. Further, it is clear that in Hogan, the recipient can

print the email from the server (160) and send using regular mail. The recipient can also choose not to open the email, and as a result, the e-mail be printed and forwarded via regular mail. Also, it is clear that the server (160) provides a graphical user interface (Figs. 3 and 4, for example) that allows a recipient to select whether electronic mail is delivered to the electronic mailbox or is delivered via traditional mail. In addition, it is clear that each recipient is assigned with an email box. It is also clear that emails can be printed and mailed via traditional mail. Furthermore, Hogan discloses that physical address and email address of a recipient are stored in a database.

However, Hogan does not disclose a means for mapping a physical address of a recipient to an email address of the recipient.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of searching a recipient's email address using a recipient's physical address, since the Examiner takes Official Notice that searching for a particular predetermined information using a key word or phrase in a data base is old and well-known; and providing Hogan with such a search capability only involves ordinary skill in the art.

The further difference between Hogan and the claimed subject matter is the method of selectively tagging or identifying a particular class of emails for delivering either electronically or via traditional mail. Daniel, Jr. et al. discloses a method of sorting emails based on method of delivery and delivery designated emails via either postal mail or email (see at least Figs. 1 and 2, and description thereof). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide

Hogan with an option of sorting mails and delivering mails based on a recipient's choice via either email or traditional mail, as taught by Daniels, Jr. et al., for the purpose of upgrading the mail system of Hogan.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan as applied to claim 5 above, and further in view of the following.

The further difference between Hogan and the claimed subject matter is tagging selected emails as time sensitive. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of tagging selected emails as time sensitive, since the Examiner takes Official Notice that tagging an email as time sensitive is old and well-known; and providing the email server of Hogan with an option of tagging selected emails as time sensitive only involves ordinary skill in the art.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan as applied to claim 5 above, and further in view of the following.

The further difference between Hogan and the claimed subject matter is the use of biometric data for accessing to an electronic mailbox. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of using biometric data for accessing to an electronic mailbox, since the Examiner takes Official Notice that biometric data is old and well-known; and providing

the email server of Hogan with an option of using biometric data for accessing to an electronic mailbox involves ordinary skill in the art.

Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zoken.

Zoken discloses a method of storing an email in an electronic mailbox and mapping the email address of a recipient to a physical address of a recipient. However, Zoken does not disclose mapping the physical address of a recipient to the email address of a recipient. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Zoken to provide the option of mapping the physical address of a recipient to the email address of a recipient, since such modification is merely a design choice and involves only ordinary skill in the art.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Savino et al.

Savino et al. discloses a method for parcel delivery notification, comprising: receiving an electronic order for a parcel (received purchase order information); generating a parcel barcode representing at least a physical address of a buyer (see at least Fig. 5 and description thereof); scanning a parcel barcode (on a shipping label/packing slip); shipping the same parcel to a parcel delivery center; and scanning the same parcel barcode at said parcel delivery center. Savino et al. does not disclose sending an email notification (email address of a buyer is contained in the bar

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code in addition to the buyer's physical address (see at least Fig. 5)) to a buyer when order is received and after shipment of order. Savino et al. also does not disclose mapping a physical address of a recipient to an email address of the recipient.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the steps of sending an email to a buyer after an on-line order is received and another email after the shipment of the order, since the Examiner takes Official Notice that sending email notification to a buyer after an on-line purchase is a common practice in e-commerce. One who places an order with Amaxon.com or Dell.com, for example, will receive such notification emails. It would also have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of searching a recipient's email address using a recipient's physical address, since the Examiner takes Official Notice that searching for a particular predetermined information using a key word or phrase in a data base is old and well-known; and providing Hogan with such a search capability only involves ordinary skill in the art.

Response to Arguments

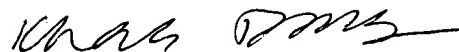
Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new grounds of rejection.

U.S. Patent Nos. 5,648,916 to Manduley is cited as relevant art.

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Any inquiry concerning this communication should be directed to Khanh Dang at
telephone number 703-308-0211.

A handwritten signature in black ink, appearing to read 'Khanh Dang', followed by a long horizontal flourish.

Khanh Dang
Primary Examiner